

**REMARKS**

Claims 1-16 are pending. By this Amendment, Claims 1, 3-10, and 13-16 have been amended.

The claims are amended to correct minor punctuation errors, eliminate multiple dependencies, and to further amplify and clarify the claimed subject matter only and not for reasons related to patentability.

**Allowed/Allowable Claims**

Applicant respectfully acknowledges and appreciates the indication by the Examiner that Claims 11-16 are allowed and that Claims 3 and 6, although objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form, including all of the features of the base claim and any intervening claims.

**Claim Rejections – 35 U.S.C. § 102**

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,979,067 issued to Waters (hereinafter referred to as “Waters ’067”). Applicant respectfully traverses the rejection.

Claim 1 recites, among other features, a heel support being mounted on a heel adjustment means arranged to simultaneously pivot said heel support about a heel toe axis and move said heel support in a direction transverse to said heel toe axis.

Waters ’067 discloses a device for measuring foot posture having a rear plate or heel support 51 pivotable about an axis defined by through-bolts 81 and 82 when an adjustment knob 32 is adjusted. The rear plate 51 attaches to rear adjustment blocks 34 and 36, which fasten to middle and rear frame blocks 25a and 24a, respectively, with

the thru-bolts 82 and 81, respectively. The middle and rear frame blocks 25a and 24a attach to a support member 25 and a frame member 24, respectively. The support and frame members 24 and 25 are rigidly attached to the frame 20. Accordingly, the rear adjustment blocks 34 and 36 and rear plate 51 are constrained to a fixed position relative to the frame 20 and may only pivot about the axis extending through the thru-bolts 81 and 82.

The Office Action reasserts the position taken in the previous Office Action dated September 10, 2004. Particularly, the Office Action asserts that the rear plate 51 of Waters '067 is arranged to pivot about a heel-toe axis while, at the same time, inherently moves transverse to the heel-toe axis, because the axis itself will change or be moved whenever the rear plate 51 is adjusted without adjusting a front plate 52. See the Office Action dated September 10, 2004, page 2, line 14 through page 3, line 2.

While the rear plate 51 does pivot about an axis extending through thru-bolts 81 and 82, the rear plate 51 does not move simultaneously in a direction transverse to the axis defined by thru-bolts 81 and 82.

Although inherency can be a proper basis for a rejection, the Office Action has the obligation to provide a basis in fact and/or technical reasoning to reasonably support how the alleged inherent characteristics necessarily flows from the teaching in the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) and M.P.E.P. § 2112(IV). Here the Office Action has failed to do so.

First, the axis about which the rear plate 51 pivots does not move in any direction when the rear plate 51 pivots. Waters '067 expressly states that the rear plate 51 pivots about thru-bolts 81 and 82. See column 6, lines 8-11 of Waters '067. Second, the thru-

bolts 81 and 82 are fixed relative to the frame 20, as described above. Therefore, it is technically impossible for the rear plate 51 of Waters '067 to simultaneously pivot about the thru-bolts 81 and 82 (the heel-toe axis) and move transverse to the heel-toe axis, because the rear plate 51 is mounted at a fixed position relative to the frame 20. The middle and rear frame blocks 25a and 24a and the bolts 81 and 82 prevent the rear plate 51 from moving in a direction transverse to the heel-toe axis, unless the entire device of Waters '067 is moved.

Accordingly, the rear plate 51 taught by Waters '067 is not arranged to or capable of simultaneously pivoting about the heel-toe axis and moving in a direction transverse to the heel-toe axis, as recited in Claim 1.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) and M.P.E.P. § 2131.

As explained above, Waters '067 does not teach or suggest each and every feature recited by Claim 1. Therefore, Applicant respectfully submits that Claim 1 is not anticipated by, or rendered obvious in view of, Waters '067 and should be deemed allowable.

Claims 2 and 4 depend directly or indirectly from Claim 1. Therefore, Applicant respectfully submits Claims 2 and 4 should be deemed allowable for the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

**Claim Rejections – 35 U.S.C. §103**

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Waters '067 in view of U.S. Patent No. 4,747,989 issued to Peterson (hereinafter referred to as "Peterson '989). Applicant respectfully traverses the rejection.

Claim 5 depends from Claim 1.

Peterson '989 discloses a method and apparatus for making corrected custom foot molds. Peterson '989 discloses a molding platform including a base 15, a knee stabilizer apparatus 18 for positioning a patient's knee, and specially-contoured cushions 34 and 35 to conform to the shape of a patient's feet. Peterson '989 does not teach or suggest a heel support being mounted on a heel adjustment means arranged to simultaneously pivot said heel support about a heel toe axis and move said heel support in a direction transverse to said heel toe axis as disclosed in Claim 1 of the present invention. Put simply, Peterson '989 does not overcome or otherwise address the above-described deficiencies of Waters '067.

To establish *prima facie* obviousness, each feature of the rejected claim must be taught or suggested by the prior art of record. See M.P.E.P. § 2143.03. Therefore, because both Waters '067 and Peterson '989 do not teach or suggest a heel support being mounted on a heel adjustment means arranged to simultaneously pivot the heel support about the heel-toe axis and move the heel support transverse to the heel-toe axis, the Applicant respectfully submits that the Office Action has failed to establish *prima facie* obviousness. As such, Applicant respectfully submits Claim 5 is not rendered obvious in view of Waters '067 and Peterson '989; submits Claim 5 should be deemed allowable for at least the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein; and requests withdrawal of the rejection.

**Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 1-16, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 026328-00006.**

Respectfully submitted,  
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